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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,820	04/28/2000	Takashi Murai	Q59071	3230
7590	06/09/2004		EXAMINER	
Sughrue Mion Zinn Macpeak & Seas PLLC 2100 Pennsylvania Avenue N W Washington, DC 20037-3202			MCANULTY, TIMOTHY P	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/559,820	MURAI, TAKASHI
	<b>Examiner</b>	<b>Art Unit</b>
	Timothy P McAnulty	3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5, 7-9 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 7-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>25</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

1. The Office action mailed 12 March 2004 as Paper No. 24, erroneously did not act on the then pending claims as amended by the amendment filed 10 October 2003 as Paper No. 22. The following is a new Office action addressing all currently amended pending claims.

#### ***Election/Restrictions***

2. Newly submitted claim 14 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 14 is drawn to a method of making a retainer for a roller bearing classified in 29/898.043 distinguished from the retainer for a roller bearing, that can be made from a materially different process, as claimed in claims 1-5 and 7-9 is classified in 384/572.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 14 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Baden.

Baden discloses in figures 1,2, and 5, a retainer for rolling bearings comprising a rolling element receiving pocket having a pair of ring shaped side plates, a pair of pillars, a first pocket surface formed in said pair of pillars and being arc shaped, a second pocket surface formed on said pair of ring shaped side plates, an escaping recess 15 located between said first pocket

surface and said second pocket surface, and a roller run-out preventing portion formed on said pair of pillars and being arc shaped.

The limitation that the pocket surfaces are formed by machining with a tool member or multiply tool members whose machining part has a sectional contour which coincides with a sectional configuration of said pocket surfaces after formation of said pocket does not further limit the retainer as claimed. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP §2113.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baden.

Baden discloses in figures 1,2, and 5, a retainer for rolling bearings comprising a rolling element receiving pocket having a pair of ring shaped side plates, a pair of pillars, a first pocket surface formed in said pair of pillars and being arc shaped, a second pocket surface formed on said pair of ring shaped side plates, and an escaping recess 15 located between said first pocket surface and said second pocket surface. Baden further discloses a roller run-out preventing portion formed on said pair of pillars and being arc shaped wherein a length of said roller run-out portion being less than or equal to a length of a roller inserted in said rolling element receiving pocket but does not specifically disclose said roller run-out portion being greater than 0.75 times

the length of said roller. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide said roller run-out portion to be greater than 0.75 times the length of said roller, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

The limitation that the pocket surfaces are formed by machining with a tool member or multiply tool members whose machining part has a sectional contour which coincides with a sectional configuration of said pocket surfaces after formation of said pocket does not further limit the retainer as claimed. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP §2113.

#### *Response to Arguments*

7. Applicant's arguments with respect to claims 1-4 and 7-9 have been considered but are moot in view of the new ground(s) of rejection. Although Baden may not specifically disclose said roller run-out preventing portion being greater than 0.75 times the roller effective length, it would have been obvious to one of ordinary skill in the art to establish such a dimensional range especially lacking any evidence to the contrary, e.g., unexpected results.

8. Applicant's arguments with respect to claim 5 have been fully considered but they are not persuasive. As presently claimed, claim 5 merely limits the roller run-out portion to have a curve surface smoothly connecting to said first pocket surface. Claim 5 does not include limitations directed to the complex geometry as depicted in Figure 7 of the instant application. As broadly

claimed, Baden discloses a first pocket surface and a roller run-out preventing portion wherein the roller run-out portion has a curve surface that smoothly connects to said first pocket surface.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tpm

  
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6/7/02